UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,042	07/19/2001	Kenichiro Matsuura	B588-021	8469

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EXAMINER
PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/909,042	MATSUURA ET AL.
	Examiner	Art Unit	
	Prieto Beatriz	2142	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☒ Claim(s) *13 and 38* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 July 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☒ All b)☐ Some * c)☐ None of:

　　　1.☒ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/03 & 1/04*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This communication is in response to Application No. 09/909,042 filed 07/19/01, claims 1-52 have been examined.

2.   Acknowledgment is made to claim priority under 35 USC 119 for the benefit of the earlier filing date with respect to Japanese Patent Application No. 2000-222814 filed July 24, 2000. A certified copy of the application has been received and placed in file.

3.   Acknowledgment is made to Information Disclosure Statement (IDS) filed pursuant to 37 C.F.R. 1.97 and 1.98, filed on 1/15/04 and 12/08/03. Respective PTO-1449 has been considered and initialed.

4.   Claim 13 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5.   Claim 14 is objected to because a minor informality, that is the use non-obvious acronyms (CITT), it is recommended this acronym be spelled-out, i.e. International Telegraph and Telephone Consultative Committee.

Claim Rejection under 35 U.S.C. 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1, 4-5, 18-19, 21, 24, 26, 29-30, 43-44, 46, 49 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,092,114) SHAFFER et. al. (hereafter referred to as Shaffer).

Regarding claim 1, Shaffer teaches substantial features of the invention. Shaffer teaches an apparatus comprising:

reception means (12) for receiving ("transmission information") messages (col 3/line 63-col 4/line 4) transmitted for or directed to a user (14, 16 or 18) (step 40 of Fig. 2, col 6/lines 6-18 and col 8/lines 35-41);

determination means (12) for determining whether contents of said received transmission information are displayable at the recipient or target client device "own" used by the user (step 46, Fig. 2, col 6/lines 54-65, col 2/lines 16-21, 30-45), including a wireless "portable" terminal (col 5/lines 51-55);

sending means (12) for sending transmission information to the portable terminal when said determination means determines that the contents are displayable at the portable terminal (step 48 of Fig. 2, col 6/lines 54-65);

decision means (12) for deciding on the basis of recipient of the transmission information received by said reception means when said determination means determines that the contents are not displayable at the recipients portable terminal (step 44 of Fig. 2, col 6/line 31-col 7/line 3, decision col 2/lines 43-65, determination col 4/lines 58-65);

designation means (12) for identifying a conversion that will convert the transmission information data into a format displayable at the recipient's portable terminal (step 52 of Fig. 2, col 6/lines 66-col 7/line 6);

providing means (12) for transmitting to the recipient's converted transmission information data on the basis of designation said designation means (step 52 and 48 of Fig. 2).

Regarding claim 4, the apparatus further comprises user information retaining means (34 of Fig. 1) for storing "retaining" information about the portable terminal (called "user information") and destination or target related information ("user information containing designation of destination") (Schaffer: col 2/lines 43-65);

said determination means determines basis of the information about the portable terminal registered in the user information whether the contents of the transmission information received by said reception means are displayable at the portable terminal owned by the destination user (Schaffer: ol 2/lines 30-65), and

said decision means decides to transmit to the destination (recipient portable device) the transmission information when the contents of the transmission information are displayable by the recipient device (this is called "destination designated by the user information") (Schaffer: steps 46 and 48 of Fig. 2).

Regarding claim 5, setting means (34) for storing "setting" the user information (Schaffer: col 2/lines 43-65).

Regarding claim 18, although Schaffer suggests downloading transmission information from a web server including HTML documents, however it does not explicitly teach when destination is an apparatus web capable device the output data is accessible by a URL.

　　Official Notice (see MPEP § 2144.03 Reliance on "Well Known" Prior Art) is taken that HTML document typically contain hyperlink having URLs embedded was old and well known in the Data Processing art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include web information accessible via URLs because URL embedded document enable user to via one document access another document, audio, video or other multi-media information via a single click.

Regarding claim 19, said providing means retains the output data accessible (Schaffer: col 4/lines 3-11) by the portable terminal (Schaffer: col 5/lines 51-55).

Regarding claim 21, this system claim is substantially the same as the method claim discussed in apparatus claim 1, wherein the reception operation is further associated to transmission operation, same rationale of rejection is applicable.

Regarding method claim 26, these are substantially the same as the apparatus claim 1, same rationale of rejection is applicable.

Regarding method claim 46, this claim is substantially the same as the system claim 21 discussed above, same rationale of rejection is applicable.

Regarding computer product claim 51, this computer-readable storage medium having the executable program for implementing the method of claim 26, same rationale of rejection is applicable.

Regarding computer product claim 52, this computer-readable storage medium having the executable program for implementing the method of claim 21, same rationale of rejection is applicable.

8.   Claims 2-3, 7-8, 22-23, 27, 32-33, 28, 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of US 6,629,130 MERTAMA et. al. (Mertama hereafter).

Regarding claim 2, although Schaffer teaches designation conversion means, which convert the transmission information in a format suitable for display by the recipient destination terminal (col 2/lines 30-65, col 8/lines 35-69), including text messages having attachments of different formats (col 1/lines 15-19); further including

identifying divided data or parts contained in the transmission information and their associated format (col 9/lines 60-64) and conversion such divided data or parts such that each part is in a suitable format displayable by the destination terminal , i.e. "integrating the respective data format-converted on the basis of the designation of said designation means" (col 9/line 65-col 10/line 15); however Schaffer does not teach division means for dividing the data contained in the transmission information;

Mertama teach a system/method related to electronic messaging system, wherein electronic mail server (11) ("division means") divide the data contained in the transmission information (e.g. e-mail) into predefined structural parts, each part associated with a data type, e.g. mail text format (col 1/lines 15-55, col 6/lines 34-38, 41-56), where these different format parts require that the destination/receipt terminal has the capability to display them (col 1/lines 56-64) including portable terminals (col 3/lines 27-29).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given to include Mertama's teachings for dividing predefined structural parts in transmission information and converting if need by the destination terminal. Motivation would be to leave the attachment of a text mail message for transmission to the destination upon determination step if attachment part found to be displayable at the destination terminal.

Regarding claim 3, the transmission information is electronic mail (Schaffer: col 3/line 63-col 4/line 3), and the data divided are attachments of predetermined format data types (Schaffer: col 5/lines 61-64, col 6/lines 20-30, identify text type message part and attachment file format part non-text type col 9/lines 60-65).

Regarding claim 7, wherein said designation means determines a programming algorithm ("conversion module") for converting a particular file format from one format to another format, for each data format type of attachment file, based on the format of each data part and a data format displayable at the

(recipient) destination, and makes the selected conversion module convert the data when needed (Schaffer: col 4/lines 45-col 5/line 21, conversion selection see col 8/lines 48-55).

Regarding claim 8, integrates the respective converted data in accordance with a structural data order (e.g. an attachment) of the transmission information (Shaffer: col 6/lines 1-5).

9.   Claims 9-10 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Mertama in further view of US 6,119,137 **SMITH et. al**. (Smith hereafter).

Regarding claim 9, when the destination is capable of receiving/providing Web information (i.e. the destination is called "a World Wide Web information providing apparatus"), Schaffer teaches converting a data to be sent to a destination according to the capabilities of the destination (Schaffer: col 4/lines 45-col 5/line 21), conversion includes converting into image data or word processing document formats (Schaffer: col 5/lines 56-64, col 6/lines 20-30 and col 4/lines 25-35, converting from a first format to a second format based on the capabilities of the destination see col 8/lines 48-56), however Schaffer does not explicitly teach converting image data into JPEG and a word processing document into HTML;

        Smith teaches determining the appropriate format for data to be delivered to a destination on the basis on the capabilities of the destination/recipient, including converting a word processing (WordPerfect) document to HTML (Smith: table 1) and image data (e.g GIF) to JPEG (Smith: tables 1 and 2).

        It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestions of Schaffer for converting email content comprising word processing documents, audio, video and graphic files or multimedia presentation, to provide the respective conversion algorithms for performing these conversion, thereby, Smith's teachings would have been readily apparent. Motivation to combine these teachings would be convert transmission information according to the recipients capability including fax machines and PDA, where further document conversion includes PDF, ENVOY, HTML, image such as JPEG, GIF, and fax data such as Group 3 and 4.

Regarding claim 10, wherein when the destination is a portable terminal (Schaffer: col 5/lines 5-55), said conversion module converts image data contained the transmission information into format displayable at the portable terminal (Schaffer: col 6/lines 20-col 7/line 11), and converts a word-processor document data into text string data (denoted as "representing a abstract of the document") (Smith: converts a word processor (e.g. WordPerfect) document col 4/lines 1-11, 44-48).

10.   Claims 6, 20, 25, 31, 45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of US 5,742,905 **PEPE et. al.** (Pepe hereafter)

Regarding claim 6, however Schaffer does not teach notification means for notifying the user of the destination portable terminal that data transferred by said providing means.

Pepe teaches notification means (40) for notifying a recipient's portable device (col 5/lines 41-53 and col 6/lines 52-59) a notification indicating data has been transferred (col 3/lines 12-15, col 5/lines 64-col 6/line 3, 11-19).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include means for notifying data transfers to the user, motivation would be to enable the user to define where information based on predetermined criteria will be delivered, including what media format and notifying the user of said delivery, this enables the user to define what media is going to be delivered to his portable terminal controlling the delivery of messages not merely based entirely on the terminal's device capabilities.

Regarding claim 20, said providing means transmits the output data to the destination, i.e. a facsimile machine (Pepe: col 8/lines 31-53 and col 23/lines 39-49).

11.   Claim 11-12 and 36-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view Mertama in further view of US 5,742,905 **PEPE et. al.** (Pepe hereafter).

Regarding claim 11, however the Schaffer and Mertama references do not each converting transmission information based on the length or size of the transmission information, e.g. email;

Pepe teaches wherein when the destination is portable terminal (e.g. a pager) and the number of characters of a mail text contained in the transmission information exceeds the number of displayable characters of the portable terminal said conversion module converts the mail text into data having the number of displayable characters (Pepe: col 26/lines 15-23).

It would have been obvious to one ordinary skilled at the time the invention was made given the suggestions of Schaffer for converting transmission information according to the capabilities of the recipient or destination device to transmit according to the capabilities of the destination device, including converting and transmitting converted transmission information according to the display and storing capacity of the destination device, thereby providing converted transmission information according to the

length (or number of characters) displayable by the destination device, preventing transmission error including to delay and possible lost of information received by the user.

Regarding claim 12, wherein said conversion module cuts a character string so that the number of characters of the mail text is not more than the number of displayable characters of the portable the document (Pepe: col 26/lines 15-23).

Claim 13, discussed above.

12.   Claims 14-15 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer-Mertama in view of Pepe in further view of US 5,881,233 **TOYODA et. al.** (Toyoda hereafter)

Regarding claim 14, wherein when the recipient ("destination") is a facsimile machine (16) (Smith: col 3/lines 36-41), further the conversion of transmission information (e.g. email) to fax (Pepe: 6/lines 1-5, col 23/lines 39-49, including transferring transmission information into facsimile data transmitted under a CCIT FAX encoding (e.g. CCITT recommendation T.434 encoding) (Pepe: col 24/lines 49-53); however the above-mentioned prior art does not teach converting mail text data, image data, and word-processor document data contained in the transmission information into facsimile data by CCITT FAX encoding.

Toyoda teaches means (5) to convert mail text data to a fax format (col 8/lines 3-10), image data in to fax format (col 1/lines 50-58), generating a cover sheet (col 3/lines 43-48).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include the teachings of Toyoda given the suggestions of Schaffer directed to message delivery systems and resource capabilities of devices in a business corporate environment, it would have been obvious to one ordinary skilled in the art to include fax machines as resource device present in this environment. Motivation to convert email and transmit to a fax would be redirect large document to fax machine diverting them from portable (low storage or displayable resource) terminals.

Regarding claim 15, comprises cover page generation means for generating cover page data representing an address of a data destination, and said providing means attaches cover page data to the facsimile data obtained (Toyoda: col 3/lines 43-48)

13.   Claims 16-17 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Mertama in further view of (US 5,859,967) KAUFELD et. al. (Kaufeld hereafter)

Regarding claims 16-17, however the above-mentioned prior art does not explicitly teach billing the user for conversion services performed.

Kaufeld teaches converting an email ("transmission information") to a fax and transmitting the facsimile and charging for this service (col 5/lines 26-28); including charging for the format conversion service (col 11/lines 51-62).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestions of Schaffer for conversion services being provide by service providers to subscriber, that billing procedures are typical in a provider-subscriber environment. Motivation to combine these teachings would be given that Schaffer's system includes a plurality of client devices that may or may not have displaying limitations to implement a pay-as-you-use system, thereby accruing charges only when the conversion is performed.

Regarding system claims 22-25, these are substantially the same as the apparatus claims 2-4 and 6, respectively, same rationale of rejection is applicable.

Regarding method claims 27-37, 39-45, these are substantially the same as the apparatus claims 2-12, 14-20, respectively same rationale of rejection is applicable.

Regarding claims 47-50, these method claims are substantially the same as system claims 22, 23, 24, and 25, respectively, same rationale of rejection is applicable.

Pertinent Prior Art:

14.   The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure; Copies of Non-Patent Literature documents cited will be provided (MPEP§ 707.05(a)):

US 6,253,231 (06/2001) System/Method for incorporating image data into e-mail documents

    FUJII teaches wherein the received input from a drawing pad or video camera is converted into graphic data (either JPEG or GIF) that is added to a template, directly incorporated into an e-mail document. Text can be added to the document via a keyboard and the whole document viewed on a display, wherein the complete e-mail is converted into HTML format for transmission over a network i.e. Internet.

US 4,893,333 (Jan 1990) Interactive facsimile system and method of information retrieval

    BARAN et. al. teach a FAX transceiver 10 optically scans each page to be transmitted, converting the input raster image into a compressed format as described in CCITT Recommendation T.4 for the Group 3 FAX transceivers, and Recommendation T.5 for the Group 4 FAX transceivers.

US 5,218,458 (Jun 1993) ASCII to ASCII transfer using FAX protocol

    Kochis et. al. teach the conversion of a file into a FAX graphical image by the transmitting system, then transmitted using a standard CCITT FAX protocol, and converted back to an ASCII format in the receiving computer system using optical character recognition (OCR); avoiding two FAX facilities be capable of directly transmitting an ASCII file, by using the CCITT standard FAX protocol.

US 6,625,642 (Sept 2003) System/process for transmitting e-mail using a conventional facsimile device

    NAYLOR et. al. teach the conversion of transmission information including the conversion to facsimile data by CCITT FAX encoding; wherein the Fax Binary File Transfer (BFT) format is defined in CCITT recommendation T.434 encoding and is a method of encoding documents and sending them by fax without converting them to an image format first.

US 6,430,272 (Aug 2002) Message switching apparatus for processing message according to message processing procedure

    MARUYAMA et. al. teaches processing an electronic message and generating an abstract of the message content including the conversion of the text message to an image data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained fro the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see http://pair-drect.uspto.gov or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

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TC 2100
Patent Examiner
November 24, 2004